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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,864	02/14/2001	Marcia Roosevelt	J25-817 US	2573
21706	7590	09/22/2005	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/782,864

Applicant(s)

ROOSEVELT ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This non-final Office action is responsive to Applicant's response to the requirement for information under 37 C.F.R. 1.105, filed June 16, 2005.

Claims 1-30 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

All of the steps recited in claims 1-30 are performed entirely by a human. Furthermore, all of these steps are completely subjective since the scope of each limitation is defined by the particular human carrying out each step. There is no

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transformation of the results of these steps into any concrete and tangible result, e.g., via a quantifiable method that repeatedly translates into real-world, meaningful, and consistent results. One skilled in the relevant art would not be able to repeatedly generate consistent and reproducible results when practicing the invention because all steps vary widely based on the human performing each step. Therefore, one skilled in the relevant art would not be able to make and/or use the invention, as intended by Applicant in light of Applicant's disclosure.

For example, how is a team coordinator selected? Who makes this selection and what standards is the selection based upon?

What are the intended metes and bounds of defining the scope of a conceptual design using a fixed-fluid analysis? Who determines which factors in the analysis are alterable and which are not? How does one person enforce his/her intended scope (i.e., created in his/her mind) when others may have created in their own mind a different scope? How are the metes and bounds of each user's scope translated into a concrete and tangible result that is consistently adhered to by a group of users?

How are all of verbal, visual, spatial, musical, emotional, worldly, practical, physical, logical, and mathematical intelligence defined and judged? Applicant's specification provides no quantifiable or otherwise concrete methodology for establishing all of these types of intelligence in a consistent fashion. In other words, since Applicant's invention is totally reliant on the subjective interpretation of a human, which will likely vary from human to human, how is intelligence consistently evaluated

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so that one user might judge a person as being musically intelligent while another user might judge the same person as musically inept?

At what level of exposure to a stimulus is a person deemed to be immersed in that stimulus? Again, such a decision is purely subjective and therefore not reproducible or concrete or tangible.

The claimed invention also recites details of conducting “energized idea generation exercises with the team members to produce an energized idea.” What is the scope of an “energized” versus “non-energized” idea? One skilled in the art would not know what the metes and bounds of such a limitation are, thereby preventing him/her from making and/or using the invention to conduct energized idea generation exercises, etc. While claim 2, for example, states that the team coordinator and at least one team member evaluate the energized idea, such an assessment is purely subjective without any transformation into a concrete and tangible result. The metes and bounds of this limitation rely entirely on the subjectivity of each user, which will likely vary from human to human without any consistent and reliable standards. Also, how does one concretely and tangibly express an appeal of the energized idea to each of the intelligences? There is no underlying scientific approach that would yield reliable, reproducible, and meaningful results when repeating practice of the invention, especially among a varying set of users.

The aforementioned problems arise throughout all of the claims, especially in relation to the steps of rejecting, accepting, defining, selecting, exposing, conducting, etc. The intended metes and bounds of the claimed invention are ambiguous since they

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are not reproducible since every human user would practice the invention differently in light of the purely subjective nature of the invention. The specification does not adequately disclose the level of details required by one skilled in the relevant art to be enabled to make and/or use the invention with consistency and confidence that the results are reproducible, tangible, concrete, and meaningful in a real-world context.

Appropriate correction and/or clarification is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the issues raised in the rejections under 35 U.S.C. § 112, 1<sup>st</sup> above bring the metes and bounds of the claims into question; therefore, these rejections are applied under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as well. All rejections under 35 U.S.C. § 112, 1<sup>st</sup> are incorporated by reference and should be addressed by the Applicant from the point of view of clarifying the scope of the claims so that the claims are no longer vague and indefinite in order to overcome the rejection under § 112, 2<sup>nd</sup> paragraph.

Appropriate correction and/or clarification is required.

*Because claims 1-30 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims.*

*See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.*

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject

matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

As discussed in the rejections of claims 1-30 above under 35 U.S.C. § 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, while claims 1-30 *might* produce a useful result, they do not produce a concrete and tangible one. Furthermore, claims 1-30 do not incorporate use of the technological arts. Therefore, claims 1-30 are deemed to be non-statutory.

Appropriate correction is required.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Siler (US 2002/0061505) -- Discloses the concept of metamorphing to tap into a person's tacit and explicit knowledge to reveal the person's strengths and weaknesses in various areas of intelligence.

Smith, Jr. (U.S. Patent No. 5,662,478) -- Discloses a method for training a group of people to generate ideas.

Gakidis et al. (US 2002/0095305) -- Discloses a system and method for evaluating ideas and their respective values.

Blasko et al. (U.S. Patent No. 6,466,928) -- Discloses a method and apparatus for idea development and evaluation.

Brooks et al. (U.S. Patent No. 5,587,935) -- Discloses a group decision support system.



The following articles discuss some of Saatchi and Saatchi's (i.e., the assignee's) experience over the years in creative idea generation:

Bushey ("CEO of Saatchi and Saatchi")

"Hummingbird Significantly Enhances Functionality of Leading Document Management Solutions"

"Saatchi Return to Roots as a Marketing Arm is Sold"

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

September 17, 2005